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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PATEL, JAY P

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/724,351	Applicant(s) LUND, ARNOLD M.	
	Examiner Jay P. Patel	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment/remarks/claims received on 7/26/2004.
2. Claims 1-5, 7 and 21-30 are pending.
3. Claims 6 and 8-20 are cancelled.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 7 of U.S. Patent No. 5949763 in view of Berkley et al. (US Patent 6546005 B1).
5. Claim 1 of the present application merely eliminates the limitation where the virtual data channel established on the packet data network reduces a load on circuit switched telephone network resources. Claim 1 of the present application instead adds

that the voice communication between the two parties is carried over the telephony network (circuit-switched) and data communication is carried over the virtual data network.

Figure 1 in Berkley shows a user 100 using the packet network 130 to communicate with multimedia PC 160 and using a POTS network to communicate with multimedia PC 150.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a voice call carried on a circuit-switched telephony network and have a data communication carried on a separate virtual data network. The motivation to combine would be properly utilize two separate networks to carry the traffic that they are respectively designed for.

In regards to claims 2-5 and 7 of the present application, they are identical to claims 2-5 and 7 of US Patent NO. 5949763.

6. Claims 21-23 and 25 of the present application are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-3 and 5 of U.S. Patent No. 6370137 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combination of claims 21 and 22 in the present application merely eliminates the step of interrogation a database having configuration information for both the calling party's and called party's CPE present in claim 2 of US Patent No. 6370137 B1.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*,

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136 USPQ 184 (CCPS). Also note *Ex parte Rainu*, 168 USPQ 375 (Bs. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art. The motivation to eliminate the above-mentioned step would be to ascertain the authenticity of the calling party at the called party's location instead from a separate database.

In regards to claim 23 of the present application, its limitations are identical to the limitations of claim 3 of US Patent No. 6370137 B1.

In regards to claim 25 of the present application, its limitations are identical to the limitations of claim 5 of US Patent No. 6370137 B1.

7. Claims 21 and 24 of the present application are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6370137 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 21 merely adds the limitation of establishing the data channel after the voice channel has been established.

However, it would have been obvious to one skilled in the art at the time the invention was made to establish the data channel after the voice channel has been established. The motivation to do so would be ascertain the availability of the called party through a voice call before establishing a data channel with the called party in order to save unnecessary data channel set up.

In regards to claim 24 of the present application, it contains the same limitation that is present as the last limitation of claim 1 of US Patent No. 6370137.

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Claims 26-30 of the present application are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-10 of U.S. Patent No. 6370137 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because present claim 26, merely eliminates the step of determining the data addresses for the calling party and the called party by a SCP by quering a database present in claim 6 of US Patent No. 6370137 B1.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPS). Also note *Ex parte Rainu*, 168 USPQ 375 (Bs. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art. The motivation to eliminate the above-mentioned step would be to ascertain the authenticity of the calling party at the called party's location instead from a separate database.

In regards to claims 27-30 of the present application, their limitations are identical to claims 7-10 of US Patent No. 6370137.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1,3-4, 7, 21, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Dunn et al. (US Patent 5916302).

10. In regards to claim 1, Dunn et al. (US Patent 5916302) disclose in figure 6, a process 36 for establishing a voice connection through a PSTN (receiving a telephone call from a calling party at a telephony network).

In further regards to claim 1, at step 37, the participants converse over a PSTN connection (establishing a voice channel over the telephony network between a called party and the calling party). At step 41 in figure 6a, image data flows from originating conferee to conference server to other conferees and is separate from voice (automatic establishment of a data channel between the called party and the calling party and carrying voice on the telephony network and data on the virtual data network).

In regards to claim 3, step 43 in figure 6a shows that the data signals represent displayable images, visual cues to be displayed and service request changes.

In regards to claim 4, at step 41 in figure 6a, image data flows from originating conferee to conference server to other conferees and is separate from voice.

In regards to claim 7, at steps 40 and 41, voice signals and data images flow between all conferees.

11. In regards to claim 21, Dunn et al. (US Patent 5916302) disclose in figure 6, a process 36 for establishing a voice connection through a PSTN (receiving a telephone call from a calling party at a telephony network).

In further regards to claim 21, at step 37, the participants converse over a PSTN connection (establishing a voice channel over the telephony network between a called

party and the calling party). At step 41 in figure 6a, image data flows from originating conferee to conference server to other conferees and is separate from voice (automatic establishment of a data channel between the called party and the calling party and a parallel synchronized operation of the voice and data channel between the calling party and the called party).

In regards to claim 23, step 43 in figure 6a shows that the data signals represent displayable images, visual cues to be displayed and service request changes.

In regards to claim 25, at steps 40 and 41, voice signals and data images flow between all conferees.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 5, 22, 26, 27, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Patent 5916302) in view of Berkley et al. (US Patent 6546005 B1).

14. In regards to claims 2, 5 and 22 Dunn teaches all the limitations of parent claims 1 and 21. Dunn however, fails to teach the determining the configurations of the parties involved, establishing the virtual data channel if the configurations are compatible and accessing a database to determine the broadband access capabilities.

Berkley however, teaches the above-mentioned limitations in the active user registry disclosed in figure 2 which is queried anytime a user need to communicate through a packet or a voice network. The database is inclusive of multimedia capabilities 280, LAN and modem IP addresses 260 and URL addresses 270. Furthermore, the calling party is contacted first with a preferred method designated by the party (see column 9, lines 37-46).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the active user registry taught by Berkley into the conference server taught by Dunn. The motivation to do so would be to ascertain the network address to place a conference call.

15. In regards to claim 26, Dunn et al. disclose in figure 6, a process 36 for establishing a voice connection through a PSTN (receiving a telephone call from a calling party at a telephony network).

In further regards to claim 26, at step 37, the participants converse over a PSTN connection (establishing a voice channel over the telephony network between a called party and the calling party over a subscriber loop). At step 41 in figure 6a, image data flows from originating conferee to conference server to other conferees and is separate from voice (automatic establishment of a data channel between the called party and the calling party and carrying voice on the telephony network and data on the virtual data network over the subscriber loop).

In further regards to claim 26, Dunn fails to teach, determining a data address for the calling party on a data network and a data address for a called party on the data network. Berkley et al. however, teach the above-mentioned limitation where a database is queried in the user registry to ascertain the identification information (see figure 2, element 260).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the active user registry taught by Berkley into the conference server taught by Dunn. The motivation to do so would be to ascertain the network address to place a conference call.

In regards to claim 29, Dunn teaches in figure 6a, at steps 40 and 41, voice signals and data images flow between all conferees.

In regards to claims 27 and 30, Dunn in combination with Berkley teaches all the limitations of parent claims 26 and 29. However, Dunn fails to teach ascertaining a data address that is an IP address. Berkley teaches the above-mentioned limitation where a database is queried in the user registry to ascertain the identification information (see figure 2, element 260).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the active user registry taught by Berkley into the conference server taught by Dunn. The motivation to do so would be to ascertain the network address to place a conference call.

16. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Patent 5916302) and Berkley et al. (US Patent 6546005 B1) as applied to claim 21 above, and further in view of Fukuoka et al. (US Patent 5914940).

17. In regards to claim 24, Dunn in combination with Berkley teaches all the limitations of parent claim 21 as stated above.

Neither Dunn nor Berkley however teaches, sending video signals over the virtual data network. Fukuoka however, teaches the above-mentioned limitation in figure 5 step S8 where a composite video packet is sent over a packetized network.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to allow the transmission of a video packet as taught by Fukuoka in the data network taught by Dunn. The motivation to do so would be allow a network user to send video signal in order to enhance the conferencing between all the parties involved.

18. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Patent 5916302) and Berkley et al. (US Patent 6546005 B1) as applied to claims 26 and 27 above and further in view of DeSimone et al. (US Patent 6138144).

In regards to claim 28, Dunn in combination with Berkley teaches all the limitations of parent claims 26 and 27. Neither Dunn nor Berkley teaches the virtual data channel using an ATM protocol.

DeSimone however, teaches the above-mentioned limitation in figure 1 where a user 101-1 establishes a connection with multicast server 130 using the ATM protocol (see column 7, lines 1-2).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to use of the ATM protocol as taught by DiSimone to set up the virtual data channel as taught by Dunn. The motivation to do so would be to allow the option of assigning the variable bit rate services that ATM allows.

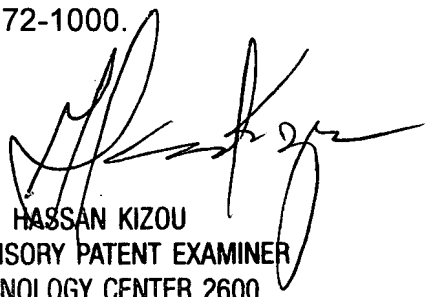
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay P. Patel whose telephone number is (571) 272-3086. The examiner can normally be reached on M-F 9:00 am - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jpp sks102
Jay P. Patel
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